

REMARKS

Favorable reconsideration is respectfully requested in light of the above amendments and the following comments. Claim 50 has been canceled. New claims 51 and 52 have been added to round out the potential scope of protection. No new matter has been added as a result of new claims 51 and 52, as these claims are fully supported for example by the originally filed Figures.

Applicants respectfully traverse the Examiner's rejection of claims 38-41, 43 and 45-50 under 35 USC § 102(b) as anticipated by Gelbfish, U.S. Patent No. 5,800,457. Applicants note that claim 50 has been canceled, leaving independent claims 38 and 39 (and dependent claims 40-41, 43 and 44-49 subject to the instant rejection). In order to anticipate, the cited reference must disclose each and every claimed element. Gelbfish fails to do so.

In particular, independent claims 38 and 39 each require that the filter is "slidably disposed along the guidewire (emphasis added)". One of ordinary skill in the art, having read the originally filed specification and claims, and having viewed the originally filed Figures, would understand that Gelbfish does not disclose a guidewire.

Rather, Gelbfish discloses element 42 (described as a wire) having a hook 44 disposed at the distal end of element 42. As shown in Figure 3C (reproduced in the Action by the Examiner), the filter 12 is disposed well distal of the hook 44. Thus, element 42 does not extend through the filter, such that it can be considered a guidewire along which the filter is slidably disposed. For at least this reason, Gelbfish fails to anticipate independent claims 38 and 39 and the claims depending therefrom.

Moreover, with respect to independent claim 38, the claim requires that the filter be slidable from a first position that is proximal the stop to a second position that is distal the stop. Assuming that hook 44 qualifies as a stop (a point not conceded by Applicants), it should be noted that Gelbfish never describes or shows a moment in which the filter is proximal to hook 44. Instead, it appears (as shown in Figure 3A) that Gelbfish discloses deploying filter 12 in a collapsed configuration partially inside tubular member 26. Element 46, which is secured to the proximal end of the filter 12, appears to be in contact with hook 44. The filter 12 itself is well distal of hook 44 and thus the filter is never in a position in which it is proximal to the hook 44. For at least this additional reason, Gelbfish fails to anticipate independent claim 38.

Further, with respect to claim 39, the claim requires that the filter be configured such that the distal end of the filter advances over the stop while the proximal end of the filter is configured to be retained by the stop. This is another feature not shown by Gelbfish. It does not appear that filter 12 itself includes any structure that is configured to be retained by a stop (again, if hook 44 can be considered to be a stop). Gelbfish discloses element 18 (described as a coupling element) and element 46 (described as a finger that can apparently interact with hook 44). Elements 18 and 46 are not believed to constitute part of filter 12 and thus cannot be considered as disclosing the claimed feature discussed herein.

Moreover, even if elements 18 and 46 are considered to be part of the filter (a point not conceded), Applicants note that element 46 is adapted to interact with hook 44 for purposes of retrieving the filter 12. It is not clear that element 46 will interact with hook 44 by simply moving the filter 12 distally to and beyond the stop. Indeed, as

illustrated for example in Figure 3C, it appears that simply moving the filter 12 distally to and beyond the hook 44 would not be sufficient to stop the filter, as element 46 and hook 44 are vertically spaced apart. This assumes, of course, that filter 12 can be positioned on wire 42 such that the distal end of the filter is proximal to the stop. Applicants do not believe that the filter 12 can be positioned in such a manner. For at least this additional reason, Gelbfish is not believed to anticipate independent claim 39.

Thus, claims 38 and 39 are patentable over Gelbfish. Similarly, dependent claims 40-41, 43 and 44-49 depend from, and add further limitations, to independent claim 39. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claim 46 under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Gelbfish, U.S. Patent No. 5,800,457. Gelbfish is distinguished above as failing to disclose the invention of claim 39, from which claim 46 depends. Claim 46 adds additional elements and similarly must be considered as patentable over Gelbfish. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claim 49 under 35 USC § 103(a) as obvious over Gelbfish, U.S. Patent No. 5,800,457. Gelbfish is distinguished above as failing to disclose the invention of claim 39, from which claim 49 depends. Claim 49 adds additional elements and similarly must be considered as patentable over Gelbfish. Favorable reconsideration is respectfully requested.

In view of the amendments and comments presented herein, favorable reconsideration in the form of a Notice of Allowance is respectfully requested. If a

telephone conference might be of assistance, please contact the undersigned attorney at
(612) 677-9050.

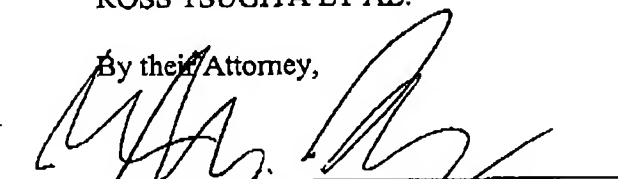
Respectfully submitted,

ROSS TSUGITA ET AL.

By their Attorney,

Date:

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